



UNITED STATES **DEPARTMENT OF COMMERCE**
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

08/738,659 10/30/96 MOTOYAMA

T EXAMINER 5244-051-2X-

LM21/0730
OBLON SPIVAK MCCLELLAND MAIER AND
NEUSTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

ART UNIT 200, L PAPER NUMBER 12

DATE MAILED 2756

07/30/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 3/9/98, 4/9/98, 5/18/98.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 10, 12-19, 36, 38-45, 52-67 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 10, 12-19, 36, 38-45, 52-67 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on 3/9/98 is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

1. Claims 10, 12-19, 36, 38-45, and 52-67 are presented for examination.
2. The amendments filed 03/09/98 and 05/18/98 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
 - a. "Stalling indicates that ... connectionless-modes of communication."
 - b. "It is well known ... SunOS 4.1.X."
 - c. "Stevens at page 441 discloses that for the Simple Mail Transfer Protocol, there is a use of a TCP connection ... electronic mail."

Applicant is required to cancel the new matter in the reply to this Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. As to claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67, applicant claims that transmitting an information as an Internet electronic mail message over the Internet which is a connectionless mode of communication. In addition, applicant discussed in the remark that Stevens clearly illustrates a connectionless-mode of communication between the user terminal and the receiver terminal because a connection is never established between the two terminals. It is well known that the Internet provides both connection and connectionless mode of communication; however, Internet electronic mail message is supported by SMTP protocol using TCP connection protocol which is connection mode of communication as described in SMTP Simple Mail Transfer Protocol by Stevens (Section 28.2 SMTP Protocol begins on page 442). Examiner do not understand what protocol applicant is using to transmit the Internet electronic mail over the Internet which is a connectionless mode of communication. Connectionless mode of communication is well known that it does not provide return messages or acknowledgments. In the contrary, Internet electronic mail supported by SMTP protocol using TCP connection protocol provides acknowledgments and it clearly described by Stevens.

7. The following is a quotation of 35 U.S.C. § 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-18, and 42-44 rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Johnston et al (Johnston)** patent no. **5,414,707**.

9. **Kraslavsky and Johnston** were cited as prior art in the last office action. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action.

10. Claims 62-64 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.

11. As to claim 62, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35); and

transmitting the information as an message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device.

12. As to claim 63, Cohn inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

13. As to claim 64, Kraslavsky and Cohn teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall in Kraslavsky and Cohn's network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank J. Asta, can be reached at (703) 305-3817.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Serial Number: 08/738,659
Art Unit: 2756

7

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).



Le H. Luu

July 20, 1998